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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/649,180

08/27/2003

Jay S. Walker

98-076-C1

5244

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7590

02/07/2008

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EXAMINER

PIERCE, WILLIAM M

ART UNIT

PAPER NUMBER

3711

MAIL DATE

DELIVERY MODE

02/07/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/649,180

Applicant(s)

WALKER ET AL.

Examiner

William M. Pierce

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3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-13,15-21,23-27 and 29-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-13,15-21,23-27 and 29-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM M. PIERCE
PRIMARY EXAMINER

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claims 35-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. While applicant points to pgs. 15-20 of the specification, it does not discuss maximum values, displaying and associating prizes as is now claimed.

Claim Rejections - 35 USC § 102

Claims 1-3, 5-11, 13, 15-21, 23-27, 29-43 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Riendeau 6,761,633 whose, based on his provisional application, has an effective filing date of 6/2/2000 as set forth in the previous office action and further in view of Smith 5,411,260.

Examiner's interpretation with respect to Riendeau is set forth in the previous office action.

Alternatively, Smith is further applied to address the limitations of claims 2 and 11. He is directed to path forming games like that of applicant's and is mostly lacking only in the "links" between the two adjacent play symbols where he indicates such a link by printing adjacent boxes. Here he has been applied to shown in games like that of applicant "wrong way" symbols 42B that form a non-continuous path in order show wrong choice. To have used "wrong way" indicia in a game like that of Riendeau as taught by the similar game to Smith would have been obvious in order to make the

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game more difficult. Further in Smith, "any one of the plurality of play symbols...is selectable. With respect to claims 1, 10, 34 and 35; 8, 17 and 32; 9, 18 and 33 and claims 19 and 26 respectively drawn to "a method of producing a scratch-off lottery ticket", a computer, an apparatus, "a method for facilitating play", the rules of play are not considered to distinguish over the applied art as being drawn to product by process claims. Alternatively, Smith teaches that a player may select any symbol as long as it forms a continuous path from one boarder to another. To have allowed the method of play of Smith in Riendeau would have been obvious in order to give the player more choice.

Claim Rejections - 35 USC § 103

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Riendeau in view of Sultan 6,273,817 as set forth in the previous office action.

Response to Arguments

Applicant's arguments filed 10/29/07 and 11/19/07 have been fully considered but they are not persuasive.

As to claims 2 and 11, each recites only "causing at least one void symbol to be printed". The negative symbols of Riendeau can be considered to be void symbols capable of being used to cause paths to be continuous and non-continuous as set forth in the previous grounds for rejection. While applicant remarks that there is "no evidence of record that such a definition would have been known to one of ordinary skill in the art", such is not the standard. The standard is only that the examiner gives the

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broadest reasonable interpretation of the claim language. Since the term "void symbol" has not been recited with any further structure (other than recitations to the rules of play), applicant has not shown where limitations in the claims distinguish over the applied art. Most broadly, consistent with applicant's specification, a "void symbol" is indicia that indicates a wrong choice. As such this rejection remains. Alternatively, Smith is directed to path forming games like that of applicant's. Mostly, Smith is lacking in only the "links" between the two adjacent play symbols. Smith indicates such a link by printing adjacent boxes. Here he has been applied to shown in games like that of applicant "wrong way" symbols 42B that form a non-continuous path.

Examiner's position with respect to the claims being structured as product by process claims is set forth in the previous office action and supported by the pre-appeals conference of 2/13/07. Applicant's position in the interpretation of the claims is not agreed with and no further comment is deemed necessary. Further applicant's remarks do not consider the teachings of the newly applied art to Smith.

Conclusion

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (571) 272-4414.


For **official fax** communications to be officially entered in the application the fax number is (703) 872-9306.

For **informal fax** communications the fax number is (703) 308-7769.

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Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.



WILLIAM M. PIERCE
PRIMARY EXAMINER